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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,463	11/24/2003	Steven W. Smith	0001-0005	4082
7590		02/27/2006	EXAMINER	
Steven W. Smith		MAY, ROBERT J		
7237 Birchwood Drive		ART UNIT		
Dallas, TX 75240-3609		PAPER NUMBER		
		2875		

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/720,463

Applicant(s)

SMITH, STEVEN W.

Examiner

Robert May

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 13-17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. <u>02152006</u> .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see Remarks, filed 25 November 2005, with respect to Claims 1, 5-6, 8-10, 12-13, 16-17, & 19 have been fully considered and are persuasive. The rejection of Claims 1, 5-6, 8-10, 12-13, 16-17, & 19 has been withdrawn.

Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection. Furthermore, the applicant contends that Held does not disclose: (1) illumination through an aperture in the front side of the casing; (2) a disk that mounts on a motor shaft that extends through the front side of the casing proximate to the illuminated aperture; and (3) a design disk having a radius that causes a portion of the disk to cover the lighted aperture in the front side of the casing when the disk is mounted on the shaft. While the examiner agrees with the 2<sup>nd</sup> assertion being the motor shaft that extends through the front side of the casing proximate to the aperture, the examiner disagrees with no's 1 and 3.

Held does disclose in Figure 1, an aperture in which the lamp 20 resides on the front side of the casing 10 and Held does disclose a design disk 23 where portions of the design disk cover the aperture and become illuminated when residing over the illuminated aperture and different portions would become illuminated if the disk was caused to rotate.

### ***Claim Objections***

Claim 13 is objected to because of the following informalities: 5<sup>th</sup> line of Claim 13 should have –rotating—before design disk because the next element refers to “said rotating design disk”.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 13-17, & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held in view of Lin (US Pat 5,706,594).

Regarding Claim 13, Held discloses in Figure 1, a nightlight with a means 20 for illuminating an area on the front surface 10 of the nightlight 19, a means for energizing

the illumination means 15, a means for interposing a design disk 23 between the illumination area 10 and the user of the nightlight, and a portion of the design disk covers the illumination area being the area in which the illumination means resides

Regarding Claim 13, Held does not disclose a means for rotating the design disk 23.

Regarding Claim 13, Lin discloses in Figure 6, a driving mechanism or motor 12 for rotating a disk 2, which is powered by a battery or ac power source (Col 2, Lines 28-30) for providing a novel decorative effect. Therefore, it would be obvious to one of ordinary skill in the art to modify the night light of Held with the rotational disk of Lin for providing novel decorative effect.

Regarding Claim 14, Held fails to disclose a battery as the energizing means.

Regarding Claim 14, Lin discloses using a battery (Col 2, Lines 26-28) so that the apparatus can be powered remotely without having to have plugged it into an electrical outlet. Therefore, it would be obvious to one of ordinary skill to modify the power source of Held with the battery power source of Lin so as to be able to remotely power the apparatus.

Regarding Claim 15, Held fails to disclose the rotating means as a dc electric motor.

Regarding Claim 15, Lin discloses using a battery as a means for driving the motor, which implies a dc electric motor for remotely powering the apparatus. Therefore, it would be obvious to one of ordinary skill to have a dc electric motor running off the battery energizing means for remotely powering the apparatus.

Regarding Claim 16, Held discloses a plug 15,17 as the energizing means for connecting the nightlight to an AC power source.

Regarding Claim 17, Held fails to disclose a rotating means being an AC electric motor.

Regarding Claim 17, Lin discloses an AC external power source for powering the rotational means (Col 2, Lines 26-27), which implies an AC electric Motor so that making an AC adaptor unnecessary for converting AC to DC if a DC motor is used. Therefore, it would be obvious to one of ordinary skill to have the AC electric motor so the apparatus can be plugged directly into an AC outlet while not requiring a DC motor.

Regarding Claim 19, Held discloses a rheostat, which controls the intensity of the light (Page 3, 1<sup>st</sup> Col, Lines 25-30) but does not disclose the rheostat as adjusting the speed of a drive shaft. However it is obvious to use the rheostat to adjust the rotational speed of the drive shaft since rearranging of parts involves routine skill in the art see *In re Japikse*.

### ***Allowable Subject Matter***

Claims 1-12 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding Claims 1 and 10, the Prior art does not teach or suggest a nightlight as recited in Claims 1 and 10 wherein a motor shaft protrude through the front side of the casing proximate to the aperture illuminated light bulb upon which the design disk is mounted.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Song (6,449,887), Chen (6,267,478), & Stekelenburg (6,499,853) disclose an illuminated apparatus with a rotating design disk.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert May whose telephone number is (571) 272-5919. The examiner can normally be reached between 9 am– 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval PAIR system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM

2/15/2006

  
ALI ALAVI  
PRIMARY EXAMINER